

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 11-13-97

TO EXAMINER: S. Marshall

M. Montgomery ROOM 6E18

APPL. S.N.: U81 468 161

ART UNIT: 1811

MAILROOM DATE 11-5-97

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

The T.D. is PROPER and has been recorded. (See 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

Application Examiner has not processed T.D. fee. (See fee authorization).

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity. (See 14.28).

is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

The T.D. is not signed. (See 14.26, 14.26.3), or 14.26.03 if TD is not signed by all the owners.

Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3) (For Samples 14.27.04 and 14.27.05)

Other: _____

Suggestion to request refund of \$ _____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- Sample of a TD over a pending application and assignee Certificate (See 14.37).
- Sample of a TD over a prior patent and assignee Certificate (See 14.38).
- Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

MERCK & CO., INC.
Patent Department
PO Box 2000 - RY 60-30
Rahway, New Jersey USA 07065-0907
Facsimile Tel. No. (732) 594-4720

#11
Terminal
D.Schaefer
11/5/97

FACSIMILE TRANSMISSION

To the Assistant Commissioner for Patents
Washington, D.C. 20231

Date of Transmission: November 5, 1997

Please deliver this facsimile to:

Facsimile No.: (703) 308-8724
Examiner: Sandra Marshall
Group Number: 1811

This facsimile is from:

Name: David A. Muthard
Location: Merck & Co., Inc., Patent Department
Rahway, New Jersey USA 07065-0907
Telephone Number: (732) 594-3903

This facsimile is in regard to:

Applicants: D. DeFeo-Jones, et al.
Serial Number: 08/468,161 Case No.: 192531B
Filing Date: June 6, 1995
Title: NOVEL PEPTIDES

Number of pages being transmitted, including cover: Thirteen (13)
(If in duplicate:) (If in triplicate: X)

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to the Patent and Trademark Office on the date shown below:

David A. Muthard

Date: November 5, 1997

IF THERE IS A PROBLEM WITH THIS TRANSMISSION,
PLEASE CONTACT GERRY EMERICK - (732) 594-6384

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Deborah Defeo-Jones, Dong-Mei Feng,
Victor M. Garsky, Raymond E. Jones and
Allen I. Olioff
Serial No. 08/468,161 (Case No. 19253IB) Group No.: 1811
Filed: June 6, 1995 Examiner: S. Marshall
For: NOVEL PEPTIDES

Commissioner of Patents and Trademarks
Washington, D.C. 20231

**TERMINAL DISCLAIMER TO OBLIGATE A DOUBLE PATENTING REJECTION
(37 CFR 1.321(b))****Identification of Person(s) Making This Disclaimer**

Name(s) of disclaimant(s) Mark R. Daniel
Residing at 64 Willis Drive, Ewing, New Jersey 08628

represent that I am

an inventor of this invention
 an assignee of this invention
 a representative authorized to sign on behalf of the assignee identified below.

Identity of Assignee and Title of Disclaimant (if applicable)

The assignee is

Name of assignee Merck & Co., Inc.

Address of assignee 126 E. Lincoln Avenue, P.O. Box 2000

Rahway, New Jersey 07065-0907

Title of disclaimant Patent Counsel

authorized to sign on behalf of assignee

Recordal of Assignment in PTO

the assignment was submitted for recordation on 10/24/97
Reel Not Yet Known
Frame Not Yet Known
 authorization for recordal of the assignment is separately attached

Extent of Interest

The extent of my(our) interest is in

the whole of this invention
 a sectional interest in this invention as follows (here state the exact interest of the disclaimant(s):

Serial No. 08/468,161

Case No. 19253IB

Page 2

Disclaimer

I hereby disclaim the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of the full statutory term of:

United States Patent No. _____, as presently shortened by any terminal disclaimer
 Any patents granted on application number(s) 08/540,412,

and hereby agree that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to

United States Patent No. _____
 Any patents granted on application number(s) 08/540,412

this agreement to run with any patent granted on the above-identified application and to be binding upon the grantor, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of

United States Patent No. _____, as presently shortened by any terminal disclaimer
 Any patents granted on application number(s) 08/540,412

in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Fee Status

(37 CFR 1.20(d) and 37 CFR 1.321)

other than a small entity--fee \$110.00
 small entity--fee \$55.00
 verified statement attached
 verified statement filed on _____

Fee Payment

Attached is a check in the sum of \$ _____.
 Charge Account 13-2755 the sum of \$ 110.00. A triplicate of this disclaimer is attached.



Signature(s) of Disclaimant(s)
Mark R. Daniel

Page 1 of 1
Amended 4/23/97

General Corporate Resolution #5

PATENT MATTERS

RESOLVED, that any of the following:

Raymond V. Gilmartin-Chairman of the Board, President and Chief Executive Officer
Mary M. McDonald-Senior Vice President and General Counsel
Joseph F. DiPrima-Vice President and Assistant General Counsel
Paul D. Matukaitis-Vice President and Assistant General Counsel
Edward Murray-Counsel, Litigation
Charles M. Caruso-Counsel, International
W. Gwyn Cole-Senior Director-European Patents
Mark R. Daniel-Counsel, Patents
David L. Rose-Counsel, Patents
Jack L. Tribble-Counsel, Patents
Melvin Winokur-Counsel, Patents
Donna L. Pollock-Administrator, Patents

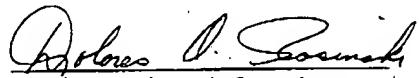
are authorized to execute and to revoke on behalf of Merck & Co., Inc. and its affiliates (including subsidiaries) the following documents relating to patent matters:

Powers of attorney as fully in law as may be necessary and proper in connection with the acquisition, registration, maintenance and enforcement of patents and applications for patents, including powers of attorney relating to the prosecution or defense of patent rights before courts of law or other governmental tribunals, agencies or departments; affidavits and declarations; and any other documents which are necessary and proper for the acquisition, registration, maintenance, litigation and protection of patents.

CERTIFICATION

I, DOLORES O. ROSINSKI, Senior Assistant Secretary of Merck & Co., Inc., a Corporation duly organized and existing under the laws of the State of New Jersey, do hereby certify that the attached, presently in full force and effect, is a true and correct copy of General Corporate Resolution #5, Patent Matters, as amended on April 23, 1997 by the Board of Directors of said Corporation at a meeting thereof duly called and held on April 23, 1997 at which a quorum was present.

IN WITNESS WHEREOF, I have hereunto subscribed my signature and affixed the seal of the Corporation this 5th day of June, 1997.


Dolores O. Rosinski
Senior Assistant Secretary

SEAL

00103-20

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Deborah Defeo-Jones, Dong-Mei Feng,
Victor M. Garsky, Raymond E. Jones and
Allen I. Oliff
Serial No. 08/468,161 (Case No. 19253IB) Group No.: 1811
Filed: June 6, 1995 Examiner: S. Marshall
For: NOVEL PEPTIDES

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Address of assignee 126 E. Lincoln Avenue, P.O. Box 2000
Rahway, New Jersey 07065-0907

Title of disclaimant Patent Counsel
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the assignment was submitted for recordal on 10/24/97
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in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

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David L. Rose-Counsel, Patents
Jack L. Tribble-Counsel, Patents
Melvin Winokur-Counsel, Patents
Donna L. Pollock-Administrator, Patents

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(including subsidiaries) the following documents relating to patent matters:

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Dolores O. Rosinski
Senior Assistant Secretary

SEAL

00105-20

TOTAL P.013